

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

FEB 4 2002

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH S. BOYCE,
GLENN A. FREITAS and CONSTANCE L. MAGEE

Appeal No. 2001-1250
Application No. 08/056,029

ORDER REMANDING TO EXAMINER

On page 3 of the Examiner's Answer mailed November 28, 1997 (Paper No. 26), the examiner listed the following references under the heading "(9) Prior Art of Record":

5,021,107
0783035

Holko
Artem

6-1991
11-1980

It is noted that the Born et al and Allum et al references cited on pages 3-5 of the Examiner's Answer under the heading "(11) Grounds of Rejection" are not included as "Prior Art of

Appeal No. 2001-1250
Application 08/056,029

Record." In accordance with § 1211 of the Manual of Patent Examining Procedure (MPEP) (7th Ed., July 1998), clarification is required regarding the pertinence of the Born et al and Allum et al references. In addition, MPEP § 1208(A)(9) states:

(A) REQUIREMENTS FOR EXAMINER'S ANSWER.
The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(9) References of Record. A listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages.

If appropriate, compliance with MPEP § 1208(A)(9) is required in listing the Born et al and Allum et al references under the heading "Prior Art of Record" appearing in the Examiner's Answer mailed November 28, 1997 (Paper No. 26). For the record, the Born et al and Allum et al references appeared on a PTO-892 attached to the Office action mailed September 11, 1995 (Paper No. 12).

In addition, page 2 of the Final Rejection mailed July 23, 1996 (Paper No. 19) lists the following rejections:

1. Claims 1, 3, 6, 9, 10, 12, 16, 18, 22 and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Born et al;

2. Claims 1, 3, 9, 10, 12, 16, 18, 22 and 24 are rejected under 35 U.S.C. § 102(b)

Appeal No. 2001-1250
Application 08/056,029

as being anticipated by 783035 Publication
. . . ;

3. Claims 2, 7, 11 and 17 are rejected
under 35 U.S.C. § 103 as being unpatentable
over Born et al . . . ; and

4. Claims 1-4, 6, 7, 9-19, 22 and 24 are
rejected under 35 U.S.C. § 103 as being
unpatentable over Holko in view of Born et
al, Allum et al and 783035 Publication.

However, in the Examiner's Answer mailed November 28, 1997 (Paper
No. 26), the only rejection listed is:

Claims 1-4, 6, 7, 9-20, 22 and 24 are
rejected under 35 U.S.C. 103(a) as being
unpatentable over the combination of Born et
al in view of Allum et al.

It should be noted that according to the Final Rejection mailed
July 23, 1996 (Paper No. 19), claim 20 was withdrawn from
consideration. Clarification is required regarding the status of
the § 102 rejections previously mentioned in the Final Rejection
and the § 103 rejection of claims 2, 7, 11 and 17 as being
unpatentable over Born et al.

Accordingly, it is

ORDERED that the application is remanded to the
examiner:

1. for clarification under MPEP § 1211 regarding the
pertinence of the Born et al and Allum et al references listed on

Appeal No. 2001-1250
Application 08/056,029

pages 3-5 of the Examiner's Answer mailed November 28, 1997
(Paper No. 26);

2. if appropriate, for compliance with MPEP
§ 1208(A)(9) by listing the Born et al and Allum et al references
in a Supplemental Examiner's Answer under the heading "References
of Record";

3. for clarification of the § 102 rejections and the
§ 103 rejection of claims 2, 7, 11 and 17 over Born; and

4. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and
Interferences be informed promptly of any action affecting the
status of the appeal (i.e., abandonment, issue, reopening
prosecution).

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

CRAIG FEINBERG
Program and Resource Administrator
(703) 308-9797

CF:psb

cc: Iandiorio & Dingman
260 Bear Hill Road
Waltham, MA 02154